

REMARKS

The Office Action of June 14, 2006 has been carefully studied. In response thereto, it is seen that claim 7 is now amended so that it has the same limitation as claim 6, requiring that the feed is a fresh feed not previously treated so as to separate di-branched and tri-branched paraffins therefrom. In addition, claim 38 is amended to correct the syntax so as to be consonant with the specification and drawings, i.e. passing effluent from at least one second hydroisomerization section to at least one second separation section.

Claim Rejections - 35 U.S.C. 112

The issue before the Examiner is whether the present claims are supported by a sufficient written description to inform a skilled artisan that the Applicant was in possession of the claimed invention as a whole at the time the application was filed. (MPEP § 2163(3) (a) and particularly (b)). The Examiner has set forth in the Office Action that the limitation in question was not found specifically in the original disclosure. This action by the Examiner is correct insofar as it shifts the burden to Applicants to show that the patent application conveys with reasonable clarity to a person of ordinary skill in the art that as of the application filing date the Applicant was in possession of the invention as set forth in *Vas-Cath Inc. v. Mahurkar*, 935 F. 2d 1555, 19 USPQ 2nd 1111, 1117 (Fed. Cir. 1991), a decision which has been followed in numerous decisions and never overruled. Attached is a Declaration Under 37 C.F.R. 1.132 by Slavik Kasztelan which provides reasons why the present application will reasonably convey to one of ordinary skill in the art the concept that the feed constituted by a C5 to C8 cut or fraction thereof containing straight chain, mono-branched, di-branched and tri-branched paraffins and including at least C7 paraffins and optionally naphthenes and aromatic compounds is a fresh feed not previously treated so as to separate di-branched and tri-branched paraffins therefrom. The Declarant, Dr. Kasztelan, sets forth on page 2 the reasons why one of ordinary skill would have had the concept at the time of the filing of the present application, for a mere reading of the application. On the one hand, there is no indication of any separation of multi-branched species prior to the feed passing to an isomerization step, and on page 16, line 23 there is the specific statement that "fresh" feed is employed. Furthermore, the second paragraph on the second page

of the Declaration explains in detail that the nature of the feed described on pages 12 and 13 of the application, including hydrocracking naphthas and cuts from atmospheric distillation as well as light reformats as noted in the last example of the specification, would include straight chain, mono-branched, di-branched and tri-branched paraffins including at least C7 paraffins. The Declarant also states that it is clear for the specification including the description of Figure 1A that fresh feeds have not been treated so as to remove the di-branched and tri-branched paraffins. Instead, the entire feed is passed to an isomerization zone and then the separation of the resultant isomerizate occurs in a subsequent step. In view of the Declaration and the explanations given therein, it is respectfully submitted that the rejection under 35 U.S.C. 112 regarding certain description is legally overcome, allowing the Examiner to withdraw the rejection.

Once the rejection under 35 U.S.C. 112 is withdrawn, it necessarily follows that the rejection under 35 U.S.C. 103 over Stem et al. 4,982,048 must also be withdrawn. The reason for this is that an essential teaching of Stem et al. is for the feed to be sent to a sophisticated separation zone so that a fraction from the separation zone can then be passed to an isomerization zone (see column 1, lines 11-16, lines 41-45 as well as column 5, lines 22-24 and lines 44-48). In contradistinction to this reference which clearly teaches one of ordinary skill in the art to employ a separation zone at first and thereafter a hydroisomerization zone, the present set of claims are all restricted to the opposite system thereby flying in the face of the teachings of the reference, thus being clearly unobvious under 35 U.S.C. 103 to one of ordinary skill in the art. In view of the emphasis of the initial separation zone in Stem et al, there would be no possible reason to modify Stem et al. to eliminate the separation zone, much less arrive at Applicants' invention. Consequently, it is respectfully submitted that claims 6 and 7 as well as those dependent thereon are clearly patentable.

Referring to other aspects of the Office Action, there is an admission on page 4 that Stem et al. does not specifically disclose that the multi-branched paraffin stream provides a minimum content of 2% weight of C₇ di-branched paraffins and does not disclose the locations and the zones as in claim 9. Nevertheless, it is stated in the Office Action that these aspects of Applicants' invention are obvious, but there is no indication of why one of ordinary skill in the art would make such modifications except for the conclusionary statement of "because the

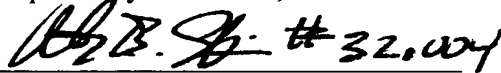
process of Stem et al. is a cyclic process and the locations of the zones would not affect the outcome of the process since the feed is ultimately passed through each zone". Applicants respectfully but firmly disagree with the latter quoted statement. In any type of continuous complex integrated refinery system, it is not predictable as to the end result of any changes in fluid compositions or the location of treatment zones. The question to be addressed under 35 U.S.C. 103 is whether it would be obvious to one of ordinary skill in the art to make such changes. To be obvious, there must be a sound scientific reason which would urge one of ordinary skill in the art to make such a change. It is respectfully and reluctantly submitted that the statement in the Office Action is thus legally irrelevant inasmuch as it is mere hindsight guess work.

In view of the submission of the Declaration by Dr. Kasztelan and the above remarks, favorable reconsideration is courteously requested.

If there are any residual problems which can be expedited by a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below, and if Counsel is not available, please call Ms. Richardson at 703-812-5326, and she will ask another attorney to be of assistance.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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